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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,982	10/30/2003	Martin Bernhard Dierl	CFLAY.00204	7863

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COLIN P. CAHOON
CARSTENS YEE AND CAHOON, L.L.P.
PO BOX 802334
DALLAS, TX 75380

EXAMINER

SIPOS, JOHN

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/696,982

Applicant(s)

DIERL ET AL.

Examiner

John Sipos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 and 9-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 5-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/03 & 7/04</u> . | 6) <input type="checkbox"/> Other: ____ |

RESTRICTION REQUIREMENT

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-4 and 9, drawn to a package, classified in Class 206.

Group II. Claims 5-8, drawn to a method of packaging, classified in Class 53, subclass 412.

Group III. Claims 10-20, drawn to an apparatus of packaging, classified in Class 53, subclass 133.4.

The inventions are distinct, each from the other, because of the following reasons:

The inventions of Groups II/III and I are related as **process/apparatus of making and product made**. The inventions are distinct if either of the following can be shown: (1) that the process as claimed can be used to make other materially different products, or (2) that the product as claimed can be made by another materially different process (See MPEP 806.05(f)) and regarding the apparatus claims (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In the instant case the package set forth in the claims of Group I can be made by a process/apparatus other than the one set forth in Groups II and III. For example, the package need not be made on a vertical form-fill-seal machine but could be made one at a time with manual tools.

It is recognized that claim 9 is a **product-by-process claims**. However, a product defined by the process by which it can be made is still a product claim and can be restricted from the process if the examiner can demonstrate that the criteria for distinction between the product

and the process, as discussed above, is met. (See *In re Bridgeford*, 149 USPQ 55 (CCPA 1966)). Defining the product in terms of a process by which it is made is merely a permissible alternative technique that applicant may use to define the product. (See MPEP 806.05(f)).

The inventions of Groups II and III are related as **process and apparatus for its practice**. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP 806.05(e)). In this case the apparatus can be used to practice a different method. For example, the machine could form a crease in an orientation other than vertical and it could seal the crease at location other than the transverse seals as required by the claimed process.

Because these inventions are distinct for the reasons given above, and because they have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes, as indicated, is proper.

Applicant is advised that the response to this requirement, to be complete, must include an election of the invention to be examined even if the restriction requirement is traversed.

During a telephone conversation between Examiner R. Hylton and Mr. C.P. Cahoon, attorney of record in this case, on May 24, 2005, a provisional election was made with traverse to prosecute the invention of Group II comprising claims 5-8. Affirmation of this election must be made by applicant in responding to this Office action. Claims 1-4 and 9-20 are withdrawn from further consideration by the examiner as being drawn to a non-elected invention. (See 37 CFR 1.142(b)). An action on the merits of the elected claims follows.

Applicant is reminded that, upon cancellation of claims to a non-elected invention, the **inventorship must be amended** in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h). Applicant should further **amend the title**, in necessary, to reflect the elected invention.

DOUBLE PATENTING REJECTION

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 5-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,722,106 and claims 1-8 of U.S. Patent No. 6,729,109.

Although the conflicting claims are not identical, they are not patentably distinct from each other because a person having ordinary skill in the art would have found the claims of the instant application to be obvious variations of the claims of the patents. The claims of the

patents and the claims of the present application are both directed to the same subject matter of forming packages on a vertical form-fill-seal machine by forming vertical creases in the film tube and after filling cross sealing and cutting the tube to form packages that can be stood up on the sides with the creases. While the claim of the present application and the claims of the patent may have variations and differences in their scope and terminology, the variations and differences would have been obvious to one having ordinary skill in the art. For example, the use of fastener or reclose tapes on film tubes in vertical form-fill-seal machines is well known in the art and their use would have been obvious to one skilled in the art. Note that applicant state on page 31 of the specification that such tapes are conventional.

REJECTIONS OF CLAIMS BASED ON PRIOR ART

The following is a quotation of 35 U.S.C. ' 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-8 are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the patent to Tsuruta (6,145,282) or Japanese Patent 2,119,159 in view of Stolmeier (5,564,259) or Terminella (6,047,521) or Admitted Prior Art. The Tsuruta and Japanese patents show the forming of a tube on a vertical form-fill-seal machine, longitudinally sealing the tube (20 and 7, respectively), forming longitudinal creases (31 and 6, respectively), transversally filling the tube, transversely sealing the tube 1510 and 5, respectively), filling the tube, transversally sealing the tube above

the product and cutting the tube into individual packages. These patents lack the use of external reclose tapes. The patents to Stolmeier and Terminella show the forming of packages on a vertical form-fill-seal machine and attaching a reclose tape (18 and 52, respectively) to the outside of the film. The instant specification also sets forth in the specification on page 32 that these tapes are conventional. It would have been obvious to one skilled in the art to provide the packages of Tsuruta or the Japanese patent with reclose tapes as taught by Stolmeeir, Terminella or the Admitted Prior Art allow easy access to the contents.

ADDITIONAL REFERENCES CITED

The following prior art is made of record but has not been relied upon in the rejection of claims. However, the prior art is considered pertinent to applicant's disclosure.

The cited art shows reclose tapes attached to the outside of film tubes.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication should be directed to **Examiner John Sipos** at telephone number **571-272-4468**. The examiner can normally be reached from 6:30 AM to 4:00 PM Monday through Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at **571-272-4467**.

The **FAX** number for Group 3700 of the Patent and Trademark Office is **(703) 872-9306**.



John Sipos
Primary Examiner
Art Unit 3721

js